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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,455	12/03/2003	Hiromichi Ito	500.40609CX2	4034

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ARLINGTON, VA 22209-3873

EXAMINER
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DOAN, PHUOC HUU

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/725,455	<b>Applicant(s)</b> ITO ET AL.	
	<b>Examiner</b> PHUOC H. DOAN	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12/03/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/25/05</u> <u>4/13/04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,693,999, and US Patent No: 6,510,212. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations are transparently found in US Patent 6,693,999, and US Patent 6,510,212 with obvious

wording variation. See following comparison of claim 1 of US Patent 6,693,999, and US Patent 6,510,212 with claim 1 of pending application.

**US Patent No: 6,693,999:** Claim 1. A program for a remote operation adaptor usable in a remote operating system which includes a portable telephone which is capable of connecting to an internet through a portable telephone network and browsing home pages and a service equipment, connected to a communication line, capable of providing home pages, said remote operation adaptor being connectable to said communication line controls home appliances, said program when executed causes said remote operation adaptor to perform the steps of: receiving contents of operation of the home electric appliance transmitted from said service equipment through said communication line; and controlling the home electric appliance connected to said remote operation adaptor unit, wherein said service equipment provides said portable telephone with home pages on a screen for giving an instruction to operate a home electric appliance, and transmits to said remote operation adaptor the contents of the operation of the home electric appliance for which an operating instruction is given by said portable telephone on a home page.

**US Patent No: 6,510,212:** Claim 1. A remote operating system comprising: a portable telephone having the function of connecting to an internet through a portable telephone network and the function of browsing home pages; a service equipment connected to a communication line for providing home pages; and a remote operation adaptor connected to the communication line and having the function of controlling home electric appliances; wherein said service equipment provides said portable telephone with home pages on a screen for giving an instruction to operate a home electric appliance, and transmits to said remote operation adaptor the contents of the operation of the home electric appliance for which an operating instruction is given by said portable telephone on a home page; and wherein said remote operation adaptor receives the contents of the operation of the home electric appliance transmitted from said service equipment through said communication line and thus controls the home electric appliance connected to said remote operation adaptor.

**Application 10/725455:** Claim 1. A service equipment for use in a remote operating system which includes a portable telephone which is capable of connecting to an internet through a portable telephone network and browsing home pages and a remote operation adaptor connected to the communication line and capable of controlling home electric appliances, said service equipment comprising: a service equipment unit, connected to a communication line, for providing home pages, wherein said service equipment unit provides said portable telephone with home pages on a screen for

giving an instruction to operate a home electric appliance, and transmits to said remote operation adaptor the contents of the operation of the home electric appliance for which an operating instruction is given by said portable telephone on a home page, and wherein said remote operation adaptor receives the contents of the operation of the home electric appliance transmitted from said service equipment unit through said communication line and thus controls the home electric appliance connected to said remote operation adaptor.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by  
**silverman (US Pub No: 2002/0110228).**

**As to claim 1,** Silverman disclose a service equipment for use in a remote operating system which includes a portable telephone “**Fig. 2**” which is capable of connecting to an internet through a portable telephone network and browsing home pages and a remote operation adaptor connected to the communication line and capable of controlling home electric appliances (page 1, par. [0012-0014]), said service equipment comprising: a service equipment unit (pag2, par. [0019-0020]),

connected to a communication line (page 2, par. [0018]), for providing home pages (page 1, par. [0013-0014]) wherein said service equipment unit provides said portable telephone with home pages on a screen for giving an instruction to operate a home electric appliance (page 2, par. [0021]), and transmits to said remote operation adaptor the contents of the operation of the home electric appliance for which an operating instruction is given by said portable telephone on a home page (page 2, par. [0023-0024]), and wherein said remote operation adaptor receives the contents of the operation of the home electric appliance transmitted from said service equipment unit through said communication line and thus controls the home electric appliance connected to said remote operation adaptor (page 2, par. [0022-0026]).

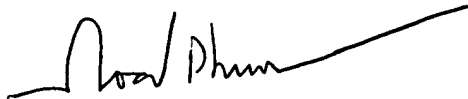
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUOC H. DOAN whose telephone number is 571-272-7920. The examiner can normally be reached on 9:30 AM - 6:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GEORGE ENG can be reached on 571-272-7495. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phuoc Doan  
04/20/06



GEORGE ENG  
SUPERVISORY PATENT EXAMINER